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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/675,208
Filing Date: September 30, 2003
Appellant(s): KLEIN ET AL.

Udo Klein et al
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/22/08 appealing from the Office action mailed 52/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,230,062	Inaki et al.	7-1993
5,450,538	Glaser et al.	9-1995
6,055,550	Wallack	4-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inaki ("Inaki" US Patent No. 5,230,062) in view of Glaser et al. ("Glaser" US Patent No. 5,450,538) and Wallack ("Wallack" US Patent No. 6,055,550).

Regarding independent claim 1, Inaki teaches a method of displaying (i.e. col. 1 line 54 et seq. of Inaki : " It is a further object of the invention to provide a data processing apparatus, in which the defined contents can be confirmed easily by displaying a predetermined character according to the character type in a defined display area in the set display size") a user input area (i.e. col. 13 line 21 et seq. of Inaki : "Thereby, the data input familiar to the user is available"), the method comprising: displaying a user input area (i.e. col. 5 line 31 et seq. of Inaki : "The record generating unit P53 displays input data from the key-board 11 in the field input area (defining display area) of the card generated by the card generating unit P51"), wherein the user input area corresponds to a data field having a specified number of characters (i.e. col. 12 line 23 et seq. of Inaki : "the character data corresponding to the field") and has a size that indicates to a user that the user input area will accommodate therein representations of the specified number of characters of the data field (i.e. col. 10 line 31 et seq. of Inaki : "At the same time, on the bottom of the display screen, there is shown that the input (defining) area has a capacity of 44 characters as "character field position definition: number of characters, the half-size, 44 characters" (calculated by the half-size) (in this case since the cursor size is set in the full-size, it corresponds to the full-size 22 characters)"), upon receipt of a user input (i.e. col. 3 line 43 et seq. of Inaki : "The key-board interface 12 identifies a pressed key, converting it into the control signal and data signal and sends to the CPU 1, which receives the signals to execute various functions") specifying a character to be included in the data field (i.e. col. 8 line 67 et seq. of Inaki : "When the cursor is moved, a character input field L1 is displayed on the bottom of the screen, then, the cursor may be moved to the field to be corrected and the right field data is inputted to the character input field L1 by the input unit 21 with the usual word processor touching"), displaying within the user input area a representation of the input character in a proportional font (i.e. col. 17 line 53 et seq. of Inaki :" the

state of field definition is displayed in such a way and the character size and area are clear at a glance"; col. 4 line 49 et seq. of Inaki : "accessing various files (document file, data file, dictionary file, font file, program file)"), adjusting based on a size of characters included in the data field and the specified number of characters of the data field, wherein the size of characters included in the data field includes a size of the input character (i.e. col. 7 line 15 et seq. of Inaki : "At the same time, there is shown on the bottom of the screen that the input (definition) area has a capacity of 30 characters (calculated in half-size) as "character field position definition: the number of characters half-size 30 characters""). Inaki does not disclose visual indication of the change in size or adjusting the size of the user input area based on the size of characters included in the data field and the specified number of characters of the data field. Glaser teaches a user input area within a computer user interface (i.e. col. 2 line 10 et seq. of Glaser : "The system, in a preferred aspect, is adapted to receive user inputs for controlling the graphical user interface, which interface provides a document form display including at least one data field for text entry"), and that the input visually (i.e. co1.2 line 2 et seq. of Glaser : " Preferably, this control capability would be provided in a visually apparent manner, indicating to the user that data fields can be expanded and suggesting the manner in which that expansion can be implemented") indicates (i.e. col. 5 line 66 et seq. of Glaser : "The size of the resizing rectangle 149 indicates to the user the change in size of the data entry field which is being expanded or contracted") to a user that the user input area will accommodate therein visual representations (i.e. col. 8 line 60 et seq. of Glaser : "and re-sizing means responsive to said pointer positioned at said predetermined location and to a re-sizing control input from said cursor control device for dynamically changing the size of said data field during text entry to accommodate additional text entry into said database"), adjusting the size of the user input area (i.e. col. 2 line 37 et seq. of Glaser : "2 illustrates a menu- driven graphical user interface display generated in accordance with the present invention including a structured form document with data entry fields and associated data descriptors, wherein one of the data entry fields is expandable in response to a user control input"), displaying the adjusted user input area having a new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the

specified number of characters of the data field (i.e. col. 2 line 22 et seq. of Glaser : "Advantageously, the system permits the customization of data input and output by enabling the user to exercise complete control over the size of the data field"; col. 2 line 17 et seq. of Glaser : "The system is responsive to a second control input from a user for conducting a resizing operation to vary the size of the data field"). It would have been obvious to an artisan at the time of the invention to combine the adjustable and visual input area of Glaser with the user input area of Inaki to create the dynamic expansion of one or more fields in a computer generated form (col. 1 line 64 et seq. of Glaser).

Wallack teaches adjusting the size of the user input area based on the size of characters included in the data field and the specified number of characters of the data field (i.e. steps 200 and 230 in FIG. 2 et seq. of Wallack). It would have been obvious to an artisan at the time of the invention to combine adjusting the size of user input as taught by Wallack into the user input area as taught by Inaki and modified by Glaser.

Said artisan would have been motivated to combine Wallack into Inaki in order to auto size the field according to textual data received in the fields in a computer-generated form (i.e. col. 2 line 23 et seq. of Wallack).

Regarding dependent claim 2, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein the user input area is displayed only when the user input area has focus (i.e. COLUMN APPOINT $70, col. 13 line 45 et seq. of Inaki: "area of defining position is appointed").

Regarding dependent claim 3, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein the user input area contains a character before the user input specifying the character is received (i.e. FIG. 131 et seq. of Inaki: "NNNN YEAR", "MM MONTH", "DD DAY", "NN HR.", "MM MIN.").

Regarding dependent claim 4, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein the user input area is empty when the input specifying the character is received (i.e. compare cursor between figures 13A and 13B et seq. of Inaki, see also col. 13 line 35 et seq. of Inaki: "wait condition of key input", "moving the cursor to a position where the time field is to be defined" and "inputting a ... suitable numeric character with a key"), and wherein the user input area size then is equal to the specified number of characters times a selected character width (i.e. CHECK HEAD CHARACTER SIZE $73, CHECK SIZE $74, see also col. 13 lines 54-58 and FIG. 12 of Inaki: data length and cursor type determine character size).

Regarding dependent claim 5, Inaki, in combination with Glaser and Wallack, teaches the method of claim 4, wherein the selected character width is an average width of characters (i.e. $73, $74, et seq. of Inaki; see also col. 13 lines 54-58 and FIG. 12 of Inaki: data length and cursor type determine character size and compare field, also note cursor and font sizes in FIGS. 11K and 11Q of Inaki).

Regarding dependent claim 6, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein the size of the user input area after the specified character is displayed equals the width of the displayed character plus the remaining number of the specified number of characters times a selected character width (i.e. $73, $74 et seq. of Inaki; see also col. 13 lines 54-58 and FIG. 12 of Inaki: data length and cursor type determine character size and compare field, also note cursor and font sizes in FIGS. 11K and 11Q of Inaki).

Regarding dependent claim 7, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein the size of the user input area is adjusted after each character that is received (i.e. $73, $74 et seq. of Inaki; see also col. 13 lines 54- 58 and FIG. 12 of Inaki: data length and cursor type determine character size, note return to step 1 after each "key input").

Regarding dependent claim 8, see the analysis of claim 1 above. Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, further comprising adjusting the size of the user input area differently (i.e. COMPARE WIDTHS $200 et seq. in Inaki) after receiving a second last character of the specified number of characters (i.e. col. 17 line 40 et seq. of Inaki: character before end mark "A", character in "NO" option from $199 of Inaki, previous to last character in step 22).

Regarding dependent claim 9, Inaki, in combination with Glaser and Wallack, teaches the method of claim 8, further comprising adjusting the user input area (i.e. COMPARE WIDTHS $200 in Inaki), after receiving the second last character (i.e. col. 17 line 40 et seq. of Inaki: character before "A" (end mark), character in "NO" option from $199 of Inaki, previous to last character in step 22), to equal a cumulative width of all characters displayed in the user input area plus a selected character width (i.e. BLOCK WIDTH = FIELD WIDTH branch from $200 et seq. of Inaki, see also CURSOR TYPE listing in FIG. 12 of Inaki).

Regarding dependent claim 10, Inaki, in combination with Glaser and Wallack, teaches the method of claim 9, wherein the selected character width is a maximum width of characters (i.e. BLOCK WIDTH = FIELD WIDTH branch from $200 et seq. of Inaki, see also CURSOR TYPE listing in FIG. 12 of Inaki especially QUADRUPLE FULL-SIZE and cursor size in FIGS. 11P and 11Q of Inaki).

Regarding dependent claim 11, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, further comprising adjusting the size of the user input area after receiving the specified number of characters, to equal a cumulative width of the characters displayed in the user input area (i.e. compare "2 CHARACTERS", "22 CHARACTERS" and "14 CHARACTERS" with active/highlighted input area in bottom right corner of FIGS. 13D, 13E and 13H et seq. of Inaki respectively).

Regarding dependent claim 12, Inaki, in combination with Glaser and Wallack, teaches the method of claim 1, wherein a user input specifying a character to be removed from the data

field is received (i.e. CANCEL KEY in FIG. 8 et seq. of Inaki, see also col. 7 lines 23-24 of Inaki: "move the cursor in the reverse direction"), further comprising displaying the user input area without the removed character, the user input area having a size equal to a cumulative width of any characters displayed in the user input area plus the remaining number of the specified number of characters times a selected character width (i.e. compare "FURIKANA" field in FIGS 11K, 11N and 110 et seq. of Inaki: despite user input, or the lack thereof, the number of characters available from FIG. 11K remains constant).

Regarding independent claim 13, Inaki teaches a computer program product containing executable instructions for displaying (i.e. col. 1 line 54 et seq. of Inaki :" It is a further object of the invention to provide a data processing apparatus, in which the defined contents can be confirmed easily by displaying a predetermined character according to the character type in a defined display area in the set display size") a user input area (i.e. col. 13 line 21 et seq. of Inaki : "Thereby, the data input familiar to the user is available"), the instructions when executed causing a processor to display the user input area (i.e. col. 5 line 31 et seq. of Inaki : "The record generating unit P53 displays input data from the key-board 11 in the field input area (defining display area) of the card generated by the card generating unit P51"), wherein the user input area corresponds to a data field having a specified number of characters and has a size that indicates to a user that the user input area will accommodate therein representations of the specified number of characters of the data field (i.e. col. 12 line 23 et seq. of Inaki : " the character data corresponding to the field"; col. 10 line 31 et seq. of Inaki : "At the same time, on the bottom of the display screen, there is shown that the input (defining) area has a capacity of 44 characters as "character field position definition: number of characters, the half-size, 44 characters" (calculated by the half-size) (in this case since the cursor size is set in the full-size, it corresponds to the full-size 22 characters)"), upon receipt of a user input specifying a character to be included in the data field (i.e. col. 3 line 43 et seq. of Inaki : "The key-board interface 12 identifies a pressed key, converting it into the control signal and data signal and sends to the CPU 1, which receives the signals to execute various functions"), display within the user input

area (i.e. col. 8 line 67 et seq. of Inaki : "When the cursor is moved, a character input field L1 is displayed on the bottom of the screen, then, the cursor may be moved to the field to be corrected and the right field data is inputted to the character input field L1 by the input unit 21 with the usual word processor touching") a representation of the input character (i.e. col. 13 line 22 et seq. of Inaki : "When data are inputted by changing the character size from the half-size to the full-size, the number of input characters is that of one half of the half-size and the input of them is impossible beyond that") in a proportional font (i.e. col. 17 line 53 et seq. of Inaki : "the state of field definition is displayed in such a way and the character size and area are clear at a glance"; col. 4 line 49 et seq. of Inaki : "accessing various files (document file, data file, dictionary file, font file, program file)"), adjust based on a size of characters included in the data field and the specified number of characters of the data field, wherein the size of characters included in the data field includes a size of the input character (i.e. col. 7 line 15 et seq. of Inaki : "At the same time, there.is shown on the bottom of the screen that the input (definition) area has a capacity of 30 characters (calculated in half-size) as "character field position definition: the number of characters half-size 30 characters""). Inaki does not disclose visual indication of the change in size or adjusting the size of the user input area based on the size of characters included in the data field and the specified number of characters of the data field.

Glaser teaches a user input area within a computer user interface (i.e. col. 2 line 10 et seq. of Glaser : "The system, in a preferred aspect, is adapted to receive user inputs for controlling the graphical user interface, which interface provides a document form display including at least one data field for text entry"), and that the input visually (i.e. co1.2 line 2 et seq. of Glaser :" Preferably, this control capability would be provided in a visually apparent manner, indicating to the user that data fields can be expanded and suggesting the manner in which that expansion can be implemented") indicates (i.e. col. 5 line 66 et seq. of Glaser : "The size of the resizing rectangle 149 indicates to the user the change in size of the data entry field which is being expanded or contracted") to a user that the user input area will accommodate therein visual representations (i.e. col. 8 line 60 et seq. of Glaser : "and re-sizing means responsive to

said pointer positioned at said predetermined location and to a re-sizing control input from said cursor control device for dynamically changing the size of said data field during text entry to accommodate additional text entry into said database"), adjusting the size of the user input area (i.e. col. 2 line 37 et seq. of Glaser : "2 illustrates a menu- driven graphical user interface display generated in accordance with the present invention including a structured form document with data entry fields and associated data descriptors, wherein one of the data entry fields is expandable in response to a user control input"), displaying the adjusted user input area having a new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters of the data field (i.e. col. 2 line 22 et seq. of Glaser : "Advantageously, the system permits the customization of data input and output by enabling the user to exercise complete control over the size of the data field"; col. 2 line 17 et seq. of Glaser : "The system is responsive to a second control input from a user for conducting a resizing operation to vary the size of the data field"). It would have been obvious to an artisan at the time of the invention to combine the adjustable and visual input area of Glaser with the user input area of Inaki to create "a preferred system" which "would be able to tailor the form by dynamically expanding one or more data entry fields" (col. 1 line 64 et seq. of Glaser) Wallack teaches adjusting the size of the user input area.based on the size of characters included in the data field and the specified number of characters of the data field (i.e. steps 200 and 230 in FIG. 2 et seq. of Wallack). It would have been obvious to an artisan at the time of the invention to combine adjusting the size of user input as taught by Wallack into the user input area as taught by Inaki and modified by Glaser. Said artisan would have been motivated to combine Wallack into Inaki in order to auto size the field according to.textual data received in the fields in a computer-generated form (i.e. col. 2 line 23 et seq. of Wallack).

Regarding dependent claim 14, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 13, wherein the size of the user input area after displaying the input character equals the width of the character plus the remaining number of the specified number of characters times a selected character width (i.e. $73, $74 et seq. of Inaki; see also col. 13 lines 54-58 and FIG. 12 of Inaki: data length and cursor type determine character size and

compare field, also note cursor and font sizes in FIGS. 11K and 11Q of Inaki).

Regarding dependent claim 15, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 13, wherein the remaining number of the specified number of characters is received in the user input area, further comprising instructions that when executed cause the processor to: display the user input area with a size equal to a cumulative width of the displayed specified number of characters in the user input area (i.e. $73, $74 et seq. of Inaki; see also col. 13 lines 54-58 and FIG. 12 of Inaki: data length and cursor type determine character size, note return to step 1 after each "key input").

Regarding dependent claim 16, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 13, further comprising instructions that when executed cause the processor to: adjust the size of the user input area differently (i.e. COMPARE WIDTHS $200 et seq. of Inaki) after receiving a second last character of the specified number of characters (i.e. character before "A" (end mark) col. 17 line 40 et seq. of Inaki, character in "NO" option from $199, previous to last character in step 22).

Regarding dependent claim 17, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 16, further comprising instructions that when executed cause the processor to: adjust the user input area (i.e. COMPARE WIDTHS $200 et seq. of Inaki), after receiving the second last character (i.e. character before "&" (end mark) col. 17 line 40 et seq. of Inaki, character in "NO" option from $199, previous to last character in step 22), to a size that is equal to a width of all characters displayed in the user input area plus a selected character width (i.e. BLOCK WIDTH = FIELD WIDTH branch from $200 et seq. of Inaki, see also CURSOR TYPE listing in FIG. 12).

Regarding dependent claim 18, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 17, wherein the selected character width is a maximum

width of characters (i.e. BLOCK WIDTH = FIELD WIDTH branch from $200 et seq. of Inaki, see also CURSOR TYPE listing in FIG. 12 especially QUADRUPLE FULL-SIZE and cursor size in FIGS. 11P and 11Q).

Regarding dependent claim 19, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 13, wherein the new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters is a different size than the size that visually indicates to a user that the user input area will accommodate therein visual representations of the specified number of characters (i.e. col. 2 line 22 et seq. of Glaser : "Advantageously, the system permits the customization of data input and output by enabling the user to exercise complete control over the size of the data field"; col. 2 line 17 et seq. of Glaser : "The system is responsive to a second control input from a user for conducting a resizing operation to vary the size of the data field").

Regarding dependent claim 20, Inaki, in combination with Glaser and Wallack, teaches the computer program product of claim 13, wherein the new size that visually indicates to the user that the user input area will accommodate therein visual representations of a remaining number of the specified number of characters is the same size as the size that visually indicates to a user that the user input area will accommodate therein visual representations of the specified number of characters (i.e. col. 2 line 22et seq. of Glaser : "Advantageously, the system permits the customization of data input and output by enabling the user to exercise complete control over the size of the data field"; col. 2 line 17 et seq. of Glaser : "The system is responsive to a second control input from a user for conducting a resizing operation to vary the size of the data field").

(10) Response to Argument

Appellant's argument focused following:

A) Whether the combination of Inaki, Glaser and Wallack teaches a user input adjusted to a new size based on a size of characters included in the data field and the specified number of characters of the data field?

A) The combination of the Glaser and Wallack teaches this limitation because Glaser teaches a user input field that is adjustable (see Galser; col. 5, lines 1-30) and Wallack teaches a data filed that is adjustable based on the size of characters and the specified number of characters. (see Wallack; col. 5, lines 40-65; figure 2, steps 200 and 230; the auto size option) Therefore the combination of Glaser and Wallack teaches a user input adjusted to a new size based on a size of characters included in the data field and the specified number of character the data filed.

B) Whether there is a motivation to combine Glaser and Wallack?

B) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wallack provides a motivation to combine its teaching with Glaser's method and that is to provid users with a mechanism to optimize the sizing of filed for user input field that maximizes the viewing of the information inputted by the user. (see Wallack; col. 2, col. 5-20)

Furthermore, the Supreme Court Stated that the Federal Circuit had erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. Specifically, as the Supreme Court pointed out, the Federal Circuit had erred in four ways:

> (1) "by holding that courts and Patent examiners should look only to the problem the patentee was trying to solve;"
> (2) by assuming "t hat a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem;"
> (3) by concluding " that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try;'" and
> (4) by overemphasizing "the risk of court and patent examiners falling prey to hindsight bias" and as a result applying "rigid preventative rules that deny fact finders recourse to common sense." KSR, 82 USPQ2d at 1397.

In the present case, the combination of Glaser and Wallack is obvious to one of ordinary skilled in the art because it provides users with a mechanism to optimize the sizing of filed for user input field that maximizes the viewing of the information filled by the user.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peng Ke

/Peng Ke/

Examiner, Art Unit 2174

Conferees:

/David A Wiley/
Supervisory Patent Examiner, Art Unit 2174

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Primary Examiner, Art Unit 2174